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In re Application of
Soren Jonsson
Application No. 08/968,034
Filed: November 12, 1997
Attorney Docket No. C-35890

: DECISION GRANTING
: PETITION
:
:

This is a decision on the petition filed November 30, 1998, as supplemented on March 22, 2000. In view of the supplement, the petition is being treated as a petition requesting that the application filed under 37 CFR 1.62 on November 12, 1997, be treated as an application filed under 37 CFR 1.53(b). A copy of the petition filed November 30, 1998, was filed by facsimile transmission on March 9, 1999. The Office sincerely apologizes for the delay in responding to the petition and any inconvenience caused petitioner by this delay.

The above-identified application was deposited on November 12, 1997 under former 37 CFR 1.62¹. The filing included a form requesting a "continuing" application under 37 CFR 1.62, as well as a complete, new specification and new drawings.

This is not a proper filing under 37 CFR 1.62. An application filed pursuant to 37 CFR 1.62 uses the specification and drawings from the prior application. Changes to the application must be made in the form of an amendment. In this application, the request as filed was accompanied by a complete new set of application papers. See 37 CFR 1.62(e).

On September 22, 1998, a "Notice of Improper FWC Filing Under 37 CFR 1.62" was mailed stating that the application was improper and had not been granted a filing date since a specification was included.

The application is improper under 37 CFR 1.62 for a second reason. The application was deposited on November 12, 1997, as a 37 CFR 1.62 application, i.e., a file wrapper continuing application (FWC), of prior application No. 08/734,817. However, application No. 08/734,817 was abandoned on September 24, 1997, since a non-final Office action was mailed on June 23, 1997, setting a three

¹ 37 CFR 1.62 was deleted from title 37 of the Code of Federal Regulation effective December 1, 1997. See Notice of Final Rule, 62 Fed. Reg. 53132 (October 10, 1997).

month shortened statutory period for response, and no extension of time was filed in the prior application. In this regard, it is noted that while a "REQUEST FOR EXTENSION IN THE TERM FOR RESPONSE" was filed November 11, 1997, requesting a two month extension, this paper was directed to the continuation-in-part application (i.e., the FWC). A petition for an extension of time must be filed as a separate paper directed toward and filed in the application to which it pertains. See MPEP 201.06 (b) and 710.02(e). Therefore, the petition for extension of time filed in the FWC application was not effective to extend the period for response set by the non-final Office action mailed June 23, 1997, in prior application No. 08/734,817 and the prior application became abandoned on September 24, 1997, prior to the date of deposit of application No. 08/968,034. A two month extension of time fee of \$200.00 was erroneously applied to application No. 08/734,817. This fee will be credited to counsel's deposit account No. 04-2219 as authorized.

This is not a proper filing under 37 CFR 1.62. An application filed under 37 CFR 1.62 must be filed "before the payment of the issue fee, abandonment of, or termination of proceedings on the prior application." Obviously, that was not done in this case. Accordingly, the request for an application under 37 CFR 1.62 based on prior application No. 08/734,817 filed on November 12, 1997 is improper.

The petition filed November 30, 1998, erroneously stated that the application was improper because a new specification which included new matter was submitted and a marked up copy showing the additions was not included on filing. The petition was accompanied by a preliminary amendment and a marked up copy of the specification. In fact, as noted above, the application was improper because it included a new specification, not because the specification was not accompanied by a marked up copy.

In response to a telephone call by the undersigned to applicant's attorney, a supplement to the petition was filed on March 22, 2000 in which petitioner, in effect, requests that the application be treated as an application filed under 37 CFR 1.53(b). Therefore, the petition is being construed as a petition requesting that the application filed on November 12, 1997, under 37 CFR 1.62 be treated as an application filed under 37 CFR 1.53(b) and be accorded a filing date of November 12, 1997.

As so construed, the petition is granted.

It is noted that the supplement to the petition filed March 22, 2000, indicates that the application is a continuation-in-part application. However, the present application may **not** claim status as a continuation (including a continuation-in-part) or divisional application of prior application No. 08/734,817, since copendency has not been established. See 35 U.S.C. §§ 120 and 121. If applicants desire to claim the benefit of prior application No. 08/734,817 under 35 U.S.C. § 120 in the present application, then appropriate steps must be promptly taken pursuant to 37 CFR 1.137 to revive prior application No. 08/734,817 to establish copendency between application No. 08/734,817 and the present application. Inquiries regarding petitions to revive should be directed to the Office of Petitions staff at (703) 305-9282.

Upon review of the record, no oath or declaration in compliance with 37 CFR 1.63 has been located among the application papers filed November 12, 1997. Therefore, an executed oath or declaration in compliance with 37 CFR 1.63 and identifying the specification to which it is

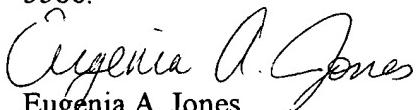
directed by application number and filing date is required. The surcharge under 37 CFR 1.16(e) is also required.

Applicant is given **ONE MONTH** from the date of this decision to file the necessary oath or declaration and the surcharge in order to avoid abandonment of the application. This time period may be extended pursuant to 37 CFR 1.136(a). The response should be directed to the attention of Initial Patent Examination Division.

The preliminary amendment filed November 30, 1998 will be entered in due course and must be considered by the examiner for entry of new matter not described in the specification as originally filed. 35 USC 112, first paragraph; 35 USC 132.

The application is being returned to Initial Patent Examination Division for further processing as an application under 37 CFR 1.53(b), not a FWC application under 37 CFR 1.62, with a filing date of November 12, 1997, using the application papers filed on November 12, 1997, and the declaration filed in response to this decision.

Telephone inquiries specific to this matter should be directed to the undersigned at (703)306-5586.



Eugenia A. Jones

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Office of the Deputy Assistant Commissioner
for Patent Policy and Projects